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Serial No. 10/782,794
Docket No. 28967.0178

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Serial No.: 10/782,794

Confirmation No.: 6789

In re Application of:

Mark Roland BOEDER

Group Art Unit: 1661

Filed: February 23, 2004

Examiner: Kent L. Bell

For: CHRYSANTHEMUM PLANT NAMED 'CETWOTONE PINK'

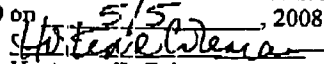
BRIEF ON APPEAL

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By:


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I. REAL PARTY IN INTEREST

The real party in interest is now Royal Van Zanten, a Dutch corporation, by merger with Chrysanthemum Breeders Association NV, whose ownership interest appears in an Assignment recorded February 23, 2004 at Reel 015014, Frame 0740.

II. RELATED APPEALS AND INTERFERENCES

There is no pending appeal or interference or judicial proceeding known to appellants, the assignee or to the undersigned that may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision in this case.

III. STATUS OF CLAIMS

This application was originally filed with a single claim, as customary in plant patent applications. On January 24, 2005 an amendment to the specification was filed, without changing the wording of the sole claim as originally filed. At no time thereafter has the sole claim of this application been amended, and an accurate text of that claim appears in the first Appendix to this brief. That sole claim is the only claim on appeal here.

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IV. STATUS OF AMENDMENTS

As indicated in part III., above, the sole claim has never been amended. No amendment was filed after the final rejection mailed April 3, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter claimed in the sole claim of this application is a new and distinct variety of chrysanthemum plant, named "CETWOTONE PINK", as described and illustrated in this application.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The final Office Action mailed April 3, 2007, page 2, stated the following rejection, reversal of which is sought by this appeal:

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by the European Plant Breeder's Right (PBR) application number 011850 published on February 15, 2002, more than one year prior to the filing date of the instant application in view of Applicant's admission that the instant cultivar was first sold in August 2002 at a flower auction in the Netherlands (reply dated January 24, 2005, page 3 and reply dated October 5, 2005, page 1) and the Royal Horticultural Society (RHS) Dictionary of Gardening 1992, vol. 1 describing how to asexually propagate a chrysanthemum plant.

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VII. ARGUMENT

A. The §102(b) Rejection of Appellant's Claim 1 Is Without Basis in Law, and in the Alleged Prior Art

Appellants' claim 1 has been rejected over

(1) European Plant Breeder's Right (PBR) application number 011850,
published February 15, 2002;

in view of: (a) the admitted fact that the claimed plant variety, named
"CETWOTONE PINK," was sold (albeit outside the United States) as
early as August 2002; and
(b) the Royal Horticultural Society (RHS) Dictionary of Gardening, vol. 1,
for the reasons stated in the final Office Action of April 3, 2007 at pages 2-4.

The Advisory Action, mailed October 31, 2007, also stated that "the basis of the 102b rejection is the published PBR application more than one year before the filing date of this application and the admitted sale of the instant cultivar by the applicant wherein the public was in possession of the instant plan more than one year before the filing date of the instant application and the RHS reference describing how to reproduce a chrysanthemum."

1. The PTO Record Admits That The Cited PBR Application Was Itself Not Enabling

The final Office Action, the Advisory Action, and all other PTO actions in this record admit that the cited, published PBR application was, by itself, not enabling of the plant partially described therein. The rejection required public availability of that plant to enable asexual reproduction thereof. The PTO is relegated to asserting that the non-enabling PBR is magically

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enabled by sale outside the United States of the relevant and necessary plant material.

First, any sale outside the United States does not qualify as de jure prior art under any part of 35 U.S.C. §102. Nor has applicant admitted that any sales outside the United States are prior art to the present application. Therefore the sales outside the United States are not available for any purpose whatsoever as prior art under §102.

Additionally, the assertion by the PTO that the late 2002 sales outside the United States provide evidence that the August 2002 publication of the PBR application "was enabled," is without evidentiary basis, and thus clearly erroneous.

A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled. Long ago our predecessor court recognized that a non-enabled disclosure cannot be anticipatory (because it is not truly prior art) if that disclosure fails to 'enable one of skill in the art to reduce the disclosed invention to practice.' In re Borst, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1962); accord, In re Donohue, [766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985).]

Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 65 USPQ2d 1385 (Fed. Cir. 2003)

As tacitly admitted, and not rebutted, in the PTO record, applicant's claimed invention cannot be produced without physical possession of the plant material. As previously demonstrated in this record, the PTO has cited no evidence that there was, or could have been, possession of such plant material in the United States more than one year before the February 23, 2004 filing date of the instant application. The August 2002 sale in the Netherlands, outside the United States, occurred only about 6 months prior to the February 23, 2003 one year date before the February 23, 2004 filing date of the instant application. It is well known in this art that such plant material cannot be imported into the United States for use without a six-month quarantine

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period before public dissemination and use. See 7 CFR §319.37-1 through 8, especially 7.

Thus it would have been impossible for anyone lawfully to have had possession of the necessary plant material in the United States more than one year before the filing date of the instant application. And, there is no evidence in this record of any such possession.

Sales outside the United States are not de jure prior art under any part of 35 U.S.C. §102. And on this record there could not have been access in the United States to the necessary plant material more than one year before appellant's filing date of the instant application. This evidentiary record does not demonstrate that there was any possession in the United States of any plant material necessary to "enable" the PBR which alone was not enabling.

While the final Office Action of April 3, 2007 cites nothing other than 35 U.S.C. §102(b) as alleged legal basis for the rejection, the prior Office Action of January 26, 2006, page 4, made passing reference to In re LeGrice, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). And, the earlier Office Action of December 17, 2004, pages 4 and 5, stated:

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. In re LeGrice, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See Ex parte Thomson, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.").

While the publication cited above discloses the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the application,

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proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant.

And, the subsequent Office Action of August 25, 2005, page 3, and the last Advisory Action mailed October 31, 2007 relied upon In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004).

Regardless of the particular wording of the rejection in the various Office Actions in this prosecution history, in essence, the rejection is based upon applicant's 2002 published PBR application as allegedly "enabled" by sale in August 2002 in the Netherlands, of the plant sought to be patented in the present application. But, the Office Actions all overreach at critical points.

In LeGrice, the CCPA held that 35 U.S.C. §161 plant patents are subject to §102(b) in the same manner as it was and is applied to other types of claimed subject matter. Importantly, the CCPA said that §102(b) and its predecessor statutes have been interpreted "as requiring that the description of the invention in the publication 'must be sufficient to put the public in possession of the invention.'" 301 F.2d at 933; emphasis added here; citing Seymour v. Osborne, 11 Wall. 516, 555, 78 U.S. 516, 555 (1870). And, the CCPA said that the disclosure of a publication, to be a statutory bar under §102(b), "must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." id. at 936; emphasis in original; citing Cohn v. U.S. Corset Co., 93 U.S. 366 (1876). The emphasis upon the cited publication being sufficient effectively to place one of skill in the relevant art in possession of the invention sought to be patented is repeated throughout LeGrice. Thomson involved a regular utility patent application seeking to patent a cotton plant and seeds thereof. Two publications describing the claimed plant and seeds were admittedly, per se.

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not enabling, but were allegedly rendered enabling by foreign availability of the plant more than one year before Thomson's U.S. application filing date. The Board in Thomson erroneously stated, without citing any basis whatsoever, "The issue is not whether...[the claimed invention]...was on public use or sale in the United States, but rather whether ...[it]...was available to a skilled artisan anywhere in the world such that he/she could obtain...and make/reproduce...[it as]...disclosed in the cited publications." 24 USPQ2d at 1620; emphasis added here. The Board in Thomson concluded that at the time that the cited articles were published, skilled artisans "throughout the world" [apparently including those in the U.S.] would have found the relevant seeds readily available [again apparently in the U.S.] and "there is no evidence of record to the contrary." Id. However, there is evidence to the contrary in the instant record.

In Elsner, the Federal Circuit, diametrically in conflict with the CCPA precedent in Le Grice, found §161 plant patent applications to be different from regular utility applications claiming a non-plant subject matter. Although the court said:

Only when possession...enables a person of skill in the art to practice asexual reproduction of the plant in a manner consistent with the statute can a non-enabling publication and foreign sale act as a § 102(b) bar.

Elsner, 381 F3d at 1128-29, emphasis added here, in fact the court found a possible bar in a manner inconsistent with the statute. In Elsner, the court found that because a published PBR application, combined with foreign sales of the plants, apparently placed the claimed inventions "in the possession of the public" that those publications demonstrated to have been enabled by the foreign sales "are proper §102(b) anticipatory references that may bar patentability." id. at

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1129; emphasis added here. But, the Federal Circuit in Elsner remanded to the PTO for further factual findings relating to the accessibility of the foreign sales and the reproducibility of the claimed plants from the plants sold.

The relevant accessibility under §102(b) should be accessible in the United States.

In the present application, there is no evidence in this record that sales in the Netherlands any time more than one year before the filing date of the present application, in fact resulted in, or could have resulted in, possession in the United States of plant material "to practice asexual reproduction of the plant" as claimed herein in a manner consistent with the statute. See Elsner 381 F. 3d at 1128-29. Accordingly, the alleged bases for alleged enablement by the disclosure of applicant's published 2002 PBR application are missing key facts which render the alleged bases for the present rejection incomplete. Therefore the rejection is inapposite.

The references alleged to support the rejection here are facially deficient for several reasons:

(1) The published PBR application document is admittedly not enabling of applicant's claimed plant variety in the absence of the plant material itself. In re LeGrice, 301 F.2d 929 (CCPA 1962).

(2) The plant "CETWOTONE PINK" was admittedly sold outside the United States more than one year before this U.S. application was filed, but it was not sold or imported into the United States before applicant's U.S. filing date. Thus, there was no §102(b) public use or sale in the United States of the claimed plant. The foreign sales of the claimed plant are not de jure prior art under §102(b) (or any other paragraph of §102), or §103.

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(3) No single cited reference among the published PBR application, the admitted foreign sale, or the RHS dictionary, was itself a complete, enabling, de jure prior art disclosure effective under §102(b) to bar patentability of applicant's claim. See 35 U.S.C. §102(b); In re LeGrice; but cf., In re Elsner, and Ex parte Thomson.

(4) There has been no showing by the PTO in this record of any evidence of anyone of even ordinary skill in the art who in the United States made and used applicant's claimed plant variety at any date more than one year before applicant's filing date. This record does not demonstrate that applicant's claimed plant (or any genetic material from which it could have been created) was ever present in the United States at any time before the filing date of this U.S. application.

§102(b) expressly identifies only matters "on sale in this country" as patent-barring acts. There is in this record no evidence of any such §102(b) "public use or on sale in this country" of applicant's claimed invention, or even elements, predecessors or genetic sources thereof. While the CCPA in LeGrice said that 35 U.S.C. §161 expressly states that plant patent applications are "subject to other conditions and requirements" of Title 35 U.S. Code, including §102(b), in fact, the Board in Thomson, and the Federal Circuit in Elsner, erroneously treated §161 plant patent applications differently from patent applications claiming other subject matter.

The statute itself must control. The statute §102(b) defines what is, and what is not, prior art under §102(b). And this record does not include any such patent-barring §102(b) prior art.

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For all the foregoing reasons, reversal of this rejection, and allowance of applicant's claim 1 are respectfully requested.

Respectfully submitted,

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APPENDIX

CLAIM ON APPEAL

1. A new and distinct variety of chrysanthemum plant as described and illustrated.

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EVIDENCE APPENDIX

No evidence was submitted in this application pursuant to any of 37 CFR §§1.130, 1.131,
or 1.132.

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RELATED PROCEEDINGS APPENDIX

As stated in part II of this brief, none.